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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,342	05/29/2001	I-Wen Winnie Tsou	078525.0103	7717
5073	7590	11/17/2008		
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980				
EXAMINER				
BEKIRMAN, MICHAEL				
ART UNIT		PAPER NUMBER		
3622				
NOTIFICATION DATE		DELIVERY MODE		
11/17/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomail1@bakerbotts.com
glenda.orrantia@bakerbotts.com

Office Action Summary

Application No.

09/870,342

Applicant(s)

TSOU ET AL.

Examiner

MICHAEL BEKERMAN

Art Unit

3622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8-18,20-24,26,28 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8-18,20-24,26,28 and 30-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/3508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

This action is responsive to papers filed on 7/15/2008.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1, 2, 4-6, 8-18 and 20-24, 26, 28, 30 and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Vries (U.S. Patent No. 6,968,179).**

Regarding claims 1, 2, 6, 18, 20, De Vries teaches transmitting business presence information (including an advertisement) to a user's wireless device based on physical location (Column 4, Lines 52-59). To receive such presence information, a user must perform a single action of arriving at a certain location (Column 11, Lines 46-54). The information service sends such information to the wireless device, and the physical device that operates the information service is a "business client system device". The user's wireless device has an instant messaging client installed thereon which handles the delivery of such location-specific messages (Column 7, Lines 35-39). De Vries teaches the storing of a number of "buddies" who wish to be notified of a user's location, those "buddies" being people who view location information of a business when the user goes to the business (Column 7, Line 55 – Column 8, Line 5).

This represents storing statistics in a database of the users who view the presence information. "Click statistics" is merely a name. Calling the statistics "click" statistics does not require any clicking actions to take place. No clicking is actively required by the claim language, and therefore the database of "buddies" who request user notifications reads over the claim language.

It could be argued that De Vries does not teach the specific data content of the physical location information as being address, phone number, directions, email address, or links. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have included any type of physical location data content in the physical location information. Such data content does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention.

Regarding claim 4, the user must first turn the wireless device on before receiving any messages. This is a step of clicking (or pressing) an "On" button.

Regarding claim 5, De Vries teaches receiving presence information when they are at a particular location (Column 11, Lines 46-54). If the device is not at that

particular location (out of range), the user must move the device within range to permit transmission of the presence information.

Regarding claims 8-12, 14, De Vries teaches multiple users with wireless devices having instant messaging clients installed thereon with buddy lists having a listing of the first instant messaging user. The first user's presence information is transmitted to the other users for viewing through the buddy list (Column 7, Line 44 - Column 8 Line 5). Any display of text indicating a user's presence is considered an "icon".

Regarding claim 13, if the first user is at a merchant location, this will be displayed to the other buddy list users independent of any selection (whether a user selects such information or not).

Regarding claims 15-17, De Vries teaches sending user-profile information for targeting purposes (Column 11, Lines 46-54). A user profile must inherently contain contact information (IP Address or other such device identifying information) in order to receive messages to the wireless device. Turning on the device reads on enabling the wireless device.

Regarding claims 21 and 24, De Vries teaches transmitting business presence information (including an advertisement) to a user's wireless device based on physical location (Column 4, Lines 52-59). To receive such presence information, a user must perform a single action of arriving at a certain location (Column 11, Lines 46-54). The information service sends such information to the wireless device, and the physical device that operates the information service is a "business client system device". The

user's wireless device has an instant messaging client installed thereon which handles the delivery of such location-specific messages (Column 7, Lines 35-39). De Vries teaches storing activity information ("statistics reports" on activity) for user's such as if the user is a coffee drinker or a vegetarian (Column 11, Lines 53-54).

It could be argued that De Vries does not teach the specific data content of the physical location information as being address, phone number, directions, email address, or links. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have included any type of physical location data content in the physical location information. Such data content does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention.

Regarding claims 22 and 23, De Vries teaches sending user-profile information for targeting purposes (Column 11, Lines 46-54). By submitting profile information, a user inherently "agrees" to submit the profile.

Regarding claim 26, the user activity preference report must be in some form of printed text information to be understood by users.

Regarding claims 28, and 32, De Vries teaches transmitting business presence information (including an advertisement) to a user's wireless device based on physical location (Column 4, Lines 52-59). To receive such presence information, a user must perform a single action of arriving at a certain location (Column 11, Lines 46-54). The information service sends such information to the wireless device, and the physical device that operates the information service is a "business client system device". The user's wireless device has an instant messaging client installed thereon which handles the delivery of such location-specific messages (Column 7, Lines 35-39). De Vries teaches multiple users with wireless devices having instant messaging clients installed thereon with buddy lists having a listing of the first instant messaging user. The first user's presence information is transmitted to the other users for viewing through the buddy list (Column 7, Line 44 - Column 8 Line 5). De Vries teaches the storing of a number of "buddies" who wish to be notified of a user's location, those "buddies" being people who view location information of a business when the user goes to the business (Column 7, Line 55 – Column 8, Line 5). This represents storing statistics in a database of the viewing of the presence information. "Click statistics" is merely a name. Calling the statistics "click" statistics does not require any clicking actions to take place. No clicking is actively required by the claim language, and therefore the database of "buddies" who wish for notification reads over the claim language.

It could be argued that De Vries does not teach the specific data content of the physical location information as being address, phone number, directions, email address, or links that contain further specific data content. However these differences

are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have included any type of physical location data content in the physical location information. Such data content does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention.

Regarding claim 30, De Vries teaches sending promotional information to users (Column 11, Lines 44-54). Should a user and another user both be nearby, they would get the same promotional message and this reads on the claim language.

Regarding claims 33 and 34, De Vries teaches instant messaging clients as interacting over the Internet (Column 1, Lines 46-50).

Regarding claim 35, De Vries teaches storing a name database (Column 13, Lines 31-46).

Regarding claim 36, De Vries teaches storing activity information ("statistics reports" on activity) for user's such as if the user is a coffee drinker or a vegetarian (Column 11, Lines 53-54).

2. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over De Vries (U.S. Patent No. 6,968,179) in view of Callegari (U.S. Pub No. 2003/0004743).

Regarding claim 31, De Vries teaches subscribing to alert and notification messages (Column 5, Lines 60-61). De Vries does not appear to specify linking a user to a website in order to subscribe. Callegari teaches a multi-user location-sharing system using buddy lists (Paragraph 0080) in which users are directed to the website of a merchant in which they are visiting (Paragraph 0108). It would have been obvious to one having ordinary skill in the art at the time the invention was made to direct a user to a merchant's website to subscribe to further notifications in the interest of having that user further view more advertising for the merchant in the form of the website.

Response to Arguments

3. Applicant argues "According to the Office Action's logic, if a claim recites that element A transmit X to element B, then X is irrelevant and the claim limitation would be met by a disclosure of element A transmitting anything to element B. Applicants submit that such an argument is not consistent with the law, patent rules, or the M.P.E.P." The basis of this rejection is that, device X that transmits data A is not patentably distinct from device X that transmits data B. The cited reference teaches transmitting location information, but does not specify the exact kind of location information. However, as long as what is transmitted can be broadly construed as location information, the fact that it's an address as apposed to a dot on a map does not make Applicant's invention distinct from the prior art. Essentially, it would be obvious to transmit any data, as the

particulars of the data are not relevant to the system components or method steps claimed. The fact that Applicant supplies a Markush grouping of types of location information is further evidence of this. Further, Examiner has cited case law that is consistent with this type of rejection. A type of data is simply not a patentable distinction.

4. Applicant argues "whether a user is a "coffee drinker or a vegetarian" is determined in De Vries by the profile or preferences that are specified by the user, it is not disclosed as being based on statistic reports on activity of said instant messaging user in selecting said business information of said business." Examiner contends that the claim language does not define the statistic reports as not being specified by the user. The portion of De Vries that was cited teaches receiving (from the user) statistic reports on the activity of the user, and those reports are used in the selecting of business information (advertisements) to supply to the user. This reads over the claim language as currently phrased.

5. Applicant argues "there is no disclosure that statistic reports are received from an instant messaging server or that they comprise information for business analysis and measurement of a marketing success of said transmitted business information". Changes to a profile would inherently occur through a server of the instant messaging network, and thus, the reports would be received from the server. The reports comprise information, but the analysis and measurement portions of the claim are intended use and do not actively limit the claim ("comprise information **for** business analysis and

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measurement of a marketing success"). Further, each of these recitations are recited in the claim language using wherein clauses, which also do not actively limit the claim.

MPEP 2114 states:

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. A claim containing a "**recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus**" if the prior art apparatus teaches all the structural limitations of the claim.

MPEP 2106 (II) (C) states:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope.

Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "**wherein**" clauses, or
- (D) "whereby" clauses.

USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. **Limitations appearing in the specification but not recited in the claim should not be read into the claim.**

6. Applicant argues that the cited portions of De Vries "do not describe sending physical location information of a business to both an instant messaging user who visits the business and to one or more "buddies" of the visiting instant messaging user". When a user of De Vries arrives a location, that location is transmitted to the other users that have subscribed to receive updates. This applies to businesses, as well as anywhere. Therefore, when the user arrives at a business, the business location information is transmitted to the other "buddy list" users. This meets the claim language.

Any changes to the rejections above have been underlined for Applicant's convenience.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMAN whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. B./

Examiner, Art Unit 3622

/Eric W. Stamber/

Supervisory Patent Examiner, Art Unit 3622